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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,433	04/06/2001	Thomas Brumm	112740-211	6084
29177	7590	03/09/2006	EXAMINER	
BELL, BOYD & LLOYD, LLC			ELALLAM, AHMED	
P. O. BOX 1135			ART UNIT	PAPER NUMBER
CHICAGO, IL 60690-1135			2668	

DATE MAILED: 03/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/827,433

Applicant(s)

BRUMM ET AL.

Examiner

AHMED ELALLAM

Art Unit

2662

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

This office action is responsive to RCE filed on 2/2/2006.

Claims 1-2, 4-19 are pending.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 1, 2, 4-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, it is not clear what is meant by claimed “ at least one part of the first signaling information is transmitted between the network element and the first subscriber such that the at least one part is configured in the interface unit according to the *signaling standard of the circuit-switching communication network*, and the *remaining part is configured as second signaling information according to the signaling standard of the packet switching network*”, because it is already stated in the claim that the first signaling information is transmitted between the network element and the first subscriber according to a *signaling standard of a circuit-switching communication network*. In particular, the transmission of information using one protocol (circuit switched in this case), while part of that information is configured in accordance with a

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packet switched protocol make no sense. Information configured to packet switched protocol cannot be transmitted using a circuit switched protocol without being converted to a format to circuit switched protocol format as known in the art. Reference is made to signaling information part that is configured to circuit-switching standard and packet switched standard, the configuration of the same signaling information using two different standard while using a transmission medium that uses only one standard is confusing, because in the act of "transmission of data" between the network element and the subscriber only one medium is used that can support only one standard protocol and not both protocols.

In addition, claim 1 indicate that the first subscriber is connected to the packet switching network, however the claim recites that the first information is transmitted between the first subscriber and the network element according to signaling standard of the circuit-switching communication network. Stated differently, the medium between the first subscriber and the network element is understood to be a packet-switched medium, however using a signaling standard of a circuit-switching network to transmit the information on such medium would amount to contradiction.

Claims 2, 4-18 depends from claim 1, thus they are subject to the same rejections.

Regarding claim 19, claim 19 suffers from the same deficiencies as in claim 1.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1, 2, 4-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding claim 1 and 19, the specification doesn't adequately describe the features of transmitting first information, such that one part of the first information is configured according to the signaling standard of a circuit-switched communication network and a remaining part is configured to signaling information according to the signaling standard of the packet-switching communication network, the first information being transmitted using a circuit-switched protocol.

Examiner notes that dependent claims 2 and 4 for example specify first signaling information corresponds to a DSS1 signaling protocol information, and the second signaling information correspond to H.323/H.450 signaling protocol information, and having the first information having both DSS1 and H.323/H.450 signals is not described in the specification. Moreover, having both DSS1 (circuit switched signaling) and H.323/H.450 (packet-switched signaling) as the transmitted **signaling information**

over a common medium (for the sake of argument the nature of the medium is irrelevant if it is a circuit switched or packet-switched) lack adequate description.

The specification for example refers to the nature of the first part and second part of "first signaling information" for example on page 11 lines 14-22 it is recited:

**The second subscriber 22 generates the signaling message, necessary for activating the "holding" feature, in accordance with the DSS1 signaling protocol. This signaling message is inserted by the subscriber 22 into a free data area of a signaling packet of the IP network 26 and transmitted to the packet control unit 14 using the signaling data packet S5. The data area within the signaling data packet is also referred to as a container. The packet control unit 14 removes the DSS1 signaling information S6 from the signaling data packet and transfers it to the switching office 12.**

It follows that the subscriber is an IP subscriber (using internet station 22) generates **signaling message in accordance with the DSS1 signaling protocol, which is inserted into an IP packet, the DSS1 signaling then is removed from the IP packet at the control unit.**

Another passage on page 4, line 11-17:

**The second subscriber 22 generates a DSS1 signaling message S12 for call forwarding. This signaling message S12 is transmitted to the packet control unit 14 using a data area of an H.323 signaling data packet 12. This transmission is carried out in the same way as was described with respect to the holding message in FIG. 2. The packet control unit 14 extracts the call forwarding S13 DSS1 signaling message from the data area and transmits it to the switching office 12.**

It follows that from the above that a data area of an H.323 signaling data packet 12 is used for DSS1 signaling message.

Thus once the DSS1 signaling message once inserted into a free area of the H.323 it becomes part of the H.323 and should be considered a message configured in accordance with an H.323 protocol and not with circuit switched protocol as recited by Applicants. Transporting a DSS1 signaling message within an H.323 is not adequately supported in the specification, because some form of conversion or processing is needed to insert data differently configured (DSS1) into the area of an H.323 packet. It is this missing step/and or processing that amount to a gap that is needed for the adequacy of description, otherwise the inserted "DSS1" can be regarded just as information bits configured as H.323 signaling bits and not "signaling information configured in accordance a circuit-switched protocol"

Claims 2, 4-18 depends from claim 1 thus they are subject to the same rejections.

### ***Response to Arguments***

4. Applicant's arguments with respect to claims 1, 2, 4-19 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: See attached form PTO-892


Any inquiry concerning this communication or earlier communications from the examiner should be directed to AHMED ELALLAM whose telephone number is (571) 272-3097. The examiner can normally be reached on 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kizou Hassan can be reached on (571) 272-3088. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AHMED ELALLAM  
Examiner  
Art Unit 2662  
March 4, 2006

1.



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